

Application No. 10/719,318
Amendment Dated: November 11, 2004
Reply to Office Action of August 13, 2004

Double Patenting Rejection

Claims 2–25 were rejected for obviousness type double patenting in view of co-owned U.S. Patent 6,693,661, which is also a parent to the present application. Applicant does not agree that the claims of the instant case are “transparently found in U.S. Patent No. 6,693,661 with obvious wording variations.” As Examiner is well aware, the cannons of claim construction dictate that the use of different words in a claim indicates an intent to create a claim of different scope. Nonetheless, in the interest of moving this case towards allowance, a terminal disclaimer is enclosed herewith. Reconsideration and withdrawal of the double patenting rejection is therefore requested.

Rejections Under § 103(a)

Each of pending claims 2–25 was also rejected under § 103(a) in view of various combinations of Ludwig, Goh, and Craig. For purposes of the following analysis, we will address only independent claims 2, 9, 10–11, 18, and 24–25. Because each of the remaining claims depends from one of these independent claims, they are necessarily allowable for at least the reasons discussed below.

Claim 2 recites:

2. A videoconferencing system, comprising:
 - a videoconferencing unit for processing and transmitting audio and video data to a plurality of users of the system through a network interface; and
 - a web server embedded within the videoconferencing unit and coupled to the network interface, for transmitting a web page in response to a request from a user, wherein the web page allows the user to select a file for broadcast to the videoconferencing unit or allows the user to view a file being transmitted by the videoconferencing unit.

Similarly, claim 9 recites:

Application No. 10/719,318
Amendment Dated: November 11, 2004
Reply to Office Action of August 13, 2004

9. A videoconferencing system, comprising:
- a videoconferencing unit for processing and transmitting audio and video data to a plurality of users of the system through a network interface; and
 - a web server embedded within the videoconferencing unit and coupled to the network interface, for transmitting a web page in response to a request from a user, wherein the web page allows the user to perform diagnostic testing on the videoconferencing unit.

Likewise, claim 10 recites:

10. A videoconferencing system, comprising:
- a videoconferencing unit for processing and transmitting audio and video data to a plurality of users of the system through a network interface; and
 - a web server embedded within the videoconferencing unit and coupled to the network interface, for transmitting a web page in response to a request from a user, wherein the web page allows the user to modify configuration parameters of the videoconferencing unit.

Examiner contends that each of claims 2, 9, and 10 is obvious in view of Ludwig and Goh. Specifically Examiner contends that "a videoconferencing unit..." is taught by Ludwig, but Examiner concedes that "Ludwig differs from the claimed invention in not specifically teaching a web server embedded within the personal computer [sic: videoconferencing unit]...." The addition of an embedded web server is common to each of claims 2-10, although each of independent claims 2, 9, and 10 recites a different web server configuration. Examiner thus relies upon Goh to supply the missing web server limitation. However, Examiner has failed to establish a *prima facie* case of obviousness, and thus Examiner's reliance upon this combination of references is improper.

A *prima facie* case of obviousness requires three things: (1) suggestion or motivation to combine the references, (2) reasonable expectation of success, and (3) teaching of each limitation of the claim within the proposed combination of references. See MPEP § 2142. Without addressing either of the second two elements, the obviousness case presented with respect to claim 2 is fatally defective because there is no

Application No. 10/719,318
Amendment Dated: November 11, 2004
Reply to Office Action of August 13, 2004

suggestion or motivation to combine the references. Furthermore, *Ludwig expressly teaches away from the combination proposed by the Examiner.*

Ludwig teaches that “[D]edicated videoconferencing systems ... do not effectively leverage the investment in existing embedded information infrastructures.... [T]hey attempt to add computing capabilities to a videoconferencing system.... [W]hile such systems may be useful ..., they do not provide the capabilities required for maximally effective collaboration, and are not cost-effective.” Ludwig at col. 2, ll. 25–39. Ludwig clearly teaches away from “add[ing] computing capabilities to a videoconferencing system.” Yet Examiner proposes to combine Goh, which teaches a form of embedded web server, and is certainly directed to additional computing capabilities, with Ludwig. This is clearly improper.

Because of Ludwig’s express teaching away from the claimed invention, there is no need to address the other elements of a *prima facie* case of obviousness. However, Applicant does not concede that each element of the claimed invention is taught by Examiner’s proposed combination. Nonetheless, reconsideration and withdrawal of the rejection of claims 2–10 in view of Ludwig and Goh is therefore requested.

Examiner noted that remaining independent claims 11 and 18 were rejected for the same reasons set forth in claim 2. Examiner further noted that claims 24 and 25 were rejected for the same reasons as claims 9 and 10, respectively. Each of these independent method claims includes an embedded web server limitation similar to the embedded web server limitation in the corresponding apparatus claim identified by Examiner. Therefore these claims are allowable for at least the reasons discussed above. Reconsideration and withdrawal of the rejection of claims 11–25 is therefore requested.

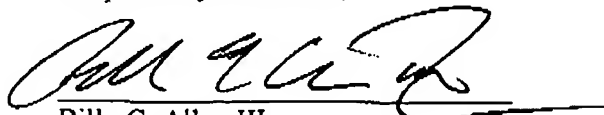
Examiner’s rejection of claims 5–6, 14–15, and 20–21 is based on Ludwig and Goh in further view of Craig. However, each of these claims depends from one of the independent claims identified above, which, as noted, are allowable. Therefore each of these claims is further allowable.

Application No. 10/719,318
Amendment Dated: November 11, 2004
Reply to Office Action of August 13, 2004

Based upon the remarks herein, allowance of all pending claims is requested.

Respectfully submitted,

November 11, 2004



Billy C. Allen III
Reg. No. 46,147

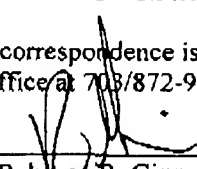
Wong, Cabello, Lutsch,
Rutherford & Brucculeri, L.L.P.
20333 State Hwy 249, Suite 600
Houston, TX 77070
Phone: 832-446-2400
Fax: 832-446-2424

CERTIFICATE OF FACSIMILE TRANSMISSION

37 C.F.R. § 1.8

I hereby certify that this correspondence is being facsimile transmitted to the U.S.
Patent and Trademark Office at 703/872-9306 on the date below.

11.11.04
Date


Rebecca R. Ginn